



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/613,548	07/03/2003	James A. Stevens	5142-001	6693
24112	7590	09/29/2004	EXAMINER	
COATS & BENNETT, PLLC P O BOX 5 RALEIGH, NC 27602			LE, TAN	
			ART UNIT	PAPER NUMBER
			3632	

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/613,548

Applicant(s)

STEVENS ET AL

Examiner

Tan Le

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-55 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-23, drawn to an assembly for reinforcing an existing tower, classified in class 52, subclass 152.
 - II. Claims 24-33, drawn to a method of reinforcing an existing tower, classified in class 52, subclass 754.04.
 - III. Claims 34-44, drawn to a tower reinforcing system, classified in class 52, subclass 651.01
 - IV. Claims 45-55, drawn to a tower reinforcing system, classified in class 52, subclass 736.4.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions II and I & III & IV are related as process and apparatus for its practice.

The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another materially different apparatus such as the apparatus having reinforcing legs mounted along at least a portion of each tower leg in the existing tower to share tower loads with the tower legs instead of having reinforcing legs mounted on adjacent legs of the existing tower to share loads with legs, or by hand, or the apparatus as claimed can be used to

practice another and materially different process such as the process having reinforcing legs mounted on adjacent legs of the existing tower to share loads with legs instead of the process having reinforcing legs mounted along at least a portion of each tower leg in the existing tower to share tower loads with the tower legs. The same for groups II & IV, typical for claims 34 & 45. This case, the process as claimed can be practiced by another materially different apparatus such as the apparatus having reinforcing legs mounted along at least a portion of each tower leg to share tower loads with the tower legs instead of the apparatus having a plurality of reinforcing legs configured to mount adjacent to the existing tower legs (34); or the process as claimed can be practiced by another materially different apparatus such as the apparatus having reinforcing legs mounted along at least a portion of each tower leg to share tower loads with the tower legs instead of the apparatus having reinforcing legs configured to mount adjacent to tower legs of the existing tower by attaching at section joints of the tower legs etc (45).

3. Inventions IV and I & II are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the particular as claimed does not claim in the combination such as each reinforcing leg mounted adjacent a leg of the existing tower such that the reinforcing leg shares loads with the leg or a plurality of braces, with each brace connected to and extending

Art Unit: 3632

between pairs of reinforcing legs mounted on adjacent legs of the existing tower (claim 1), or each of reinforcing leg is crossed braced with at least one other reinforcing leg to form a reinforcing structural network surrounding at least a portion of the existing tower (claim 34). Each of the subcombination in this case has separate utility such as a support structure attaching to an existing pole of the house for reinforcing the pole (claim 1) and a support structure surrounding at least a portion of the pole to build or extend the pole (claim 34).

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

The species of :

Figs. 1-3, 4, 6A-6C, 7A-7F, 8A-8B, 9A-9C, 10.

Figs. 1-3, 5A, 5E, 5F, 6A-6C, 7A-7F, 8A-8B, 9A-9C, 10.

Figs. 1-3, 5B, 6A-6C, 7A-7F, 8A-8B, 9A-9C, 10.

Figs. 1-3, 5C, 6A-6C, 7A-7F, 8A-8B, 9A-9C, 10.

Figs. 1-3, 5D, 6A-6C, 7A-7F, 8A-8B, 9A-9C, 10.

Figs. 1-3, 11, 6A-6C, 7A-7F, 8A-8B, 9A-9C

Figs. 1-3, 12A-12B, 6A-6C, 7A-7F, 8A-8B, 9A-9C

Figs. 1-3, 13A-13B, 6A-6C, 7A-7F, 8A-8B, 9A-9C

Figs. 1-3, 14-15, 6A-6C, 7A-7F, 8A-8B, 9A-9C

Figs. 1-3, 16, 17, 6A-6C, 7A-7F, 8A-8B, 9A-9C

Figs. 1-3, 18

Figs. 1-3, 19

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 45 appears to be generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over

the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

6. A telephone call was made to Mr. Michael Murphy on September 23, 2004 to request an oral election to the above restriction requirement, but did not result in an election being made.


Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tan Le whose telephone number is (703) 305-8244. The examiner can normally be reached on Mon. through Fri. from 9:00AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on (703) 308-2156. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Tan Le
Patent Examiner
September 23, 2004.